

**REMARKS-General**

The newly drafted independent claim 30-40 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 30-40 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

**Response to Rejection of Claims 15-29 under 35USC103**

The Examiner rejected claims 15, 16, 19, 22, 23, 25, 27 and 28 under 35USC103(a) as being unpatentable over Vaisanen (US 6,382,279) in view of Sibole (US 767,175). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Vaisanen which is qualified as prior art of the

instant invention under 35USC102(b) are obvious in view of Sibole at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

The applicant respectfully submits that the differences between the instant invention and Vaisanen are not obvious in view of Sibole under 35USC103(a), due to the following reasons:

(A) Regarding the newly drafted independent claims 30 and 37, Vaisanen and Sibole fails to anticipate a basket made from a predetermined tree trunk having an inner wood section and an outer wood section formed by bark of the tree trunk for surrounding the inner wood section, wherein the basket comprises: a tree-made portion, which has: a top surface formed by a first cut of the tree trunk across the inner wood section and the outer wood section; a bottom surface formed by a second cut of the tree trunk across the inner wood section and the outer wood section, wherein the top surface is spacedly apart from the bottom surface; and a portion body integrally extended between the top surface and the bottom surface, and defines **a cavity** within the portion body, wherein a physical contour of the portion body follows a natural geometrical contour of such portion of the tree trunk between the first cut and the second cut, so that an appearance of the tree-made portion constitutes a natural appearance of the tree trunk for carrying an object within the hollow cavity, wherein the portion body further has **an inner portion layer** formed by the inner wood section of the tree-trunk for forming the cavity within the portion body, and an **outer portion layer** which is formed by the outer wood portion of the tree trunk to constitute the corresponding natural appearance of the portion body as the natural appearance of the outer wood portion of the tree trunk, wherein the tree-made portion comprises a handle **integrally extended** from the portion body for allowing the portion body to be carried via the handle, wherein the handle is formed by **carving** the tree trunk at the top surface of the tree-made portion.

(B) The examiner is of the view that it would have been obvious for one having ordinary skill in the art to have incorporated the use of the bark on the outside of the trunk to provide an alternate method for providing the visual appearance desired by Vaisanen. The applicant respectfully disagrees. Vaisanen generally discloses a cylindrical hollow blank separated longitudinally from inside an elongated block of wood by axial boring, the blank is dried and its outer and inner surface **finished**, (e.g. by

milling, turning and sanding) and a **bottom piece**, and if required, a **lid** are then added to form a container (Vaisanen, Abstract). It is clear from the above succinct summary of disclosure that the container described in Vaisanen requires surface finishing, a bottom piece and a lid. These are **not required** in the instant invention as recited in the newly drafted independent claims 30 and 37. In fact, natural imperfection is expressly shown as a feature of the instant invention. The applicant respectfully points out that natural imperfection and perfect natural finish are opposite to each other in the sense that a truly or a high quality surface finish necessarily remove the natural imperfection formed on the basket of the instant invention.

(C) It is clear from the disclosure of the instant invention that in order to preserve the natural appearance of the tree trunk as shown in the resulting basket, surface finishing is not a feature of the instant invention. Rather, the bark is intentionally preserved to allow the basket to retain its natural appearance as that of a true tree trunk. Vaisanen differs from the instant invention in this particular respect.

(D) In Vaisanen, there is a lid covering the cavity (17) whereas in the instant invention, a handle is integrally extended from the portion body for allowing the portion body to be carried via the handle. The applicant respectfully submits that when a lid is covered on top of the portion body, the handle could not have been formed.

(E) Similarly, the instant invention does not involve a separately provided bottom piece. Rather, the portion body is an integral body formed by the inner portion layer and the outer portion layer. The applicant respectfully argue that when the basket contains a case part (9), a lid (3) and a bottom piece (2), the natural appearance of the resulting product is substantially compromised.

(F) The resulting product (i.e. the combination) of Vaisanen and Sibole is not capable of being portable and hand-held, whereas in the instant invention, the basket is handheld and conveniently portable by means of the handle. In order for the combination of Vaisanen and Sibole to be conveniently portable, some sorts of handles and locks (for locking the lid with the case part and the bottom piece with the case part) must be incorporated. These features (i.e. distinct parts and locks and artificial handles) substantially affect the natural appearance of the resulting product.

(G) In other words, there is no motivation, teaching or suggestion to combine Vaisanen with Sibole to produce the instant invention. Moreover even combining Vaisanen and Sibole would not provide the invention as claimed -- a clear indicia of nonobviousness. Ex parte Schwartz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992) That is, modifying Vaisanen with Sibole, as proposed by the examiner, would not have produce the instant invention as recited in the newly drafted independent claims 30 and 37, at least because of the curtailed natural appearance from a possible combination of Vaisanen and Sibole as suggested by the examiner.

(H) The applicant respectfully submits that to reject claims in a patent application under 35 U.S.C. 103, the Examiner must show an un rebutted prima facie case of obviousness. See In re Deuel, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

A prima facie case of obviousness requires setting forth:

- (a) the differences in the claim over the applied references,
- (b) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (c) an explanation why such proposed modification would be obvious. MPEP §706.02.

In establishing a prima facie case of obviousness, the Examiner must make the four factual inquiries sent forth by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). Specifically, the four factual inquiries required by Graham are as follows:

- (a) Determining of the scope and contents of the prior art;
- (b) Ascertaining the differences between the prior art and the claims in issue;
- (c) Resolving the level of ordinary skill in the pertinent art; and
- (d) Evaluating evidence of secondary consideration.

These factors have not been appropriately applied in this case. In addition, when applying 35 USC 103, the following tenets of patent law must be adhered to:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (c) The references must be viewed without the benefit of hindsight vision afforded by the claimed invention; and
- (d) Reasonable expectation of success is the standard with which obviousness is determined. Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

As mentioned in the preceding paragraphs, since Vaisanen discloses that a lid and a bottom piece may need to be used, there is no reasonable expectation of success for combining Vaisanen and Sibole ***in order to produce the instant invention***.

Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

#### **The Cited but Non-Applied References**

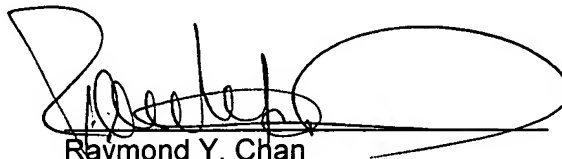
The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

A fee in an amount of US\$405.00 is submitted herewith to pay the fee for Request for Continued Examination (RCE). This amount is believed to be correct. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 502111.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 30-40 at an early date is solicited.

Should the examiner believes that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

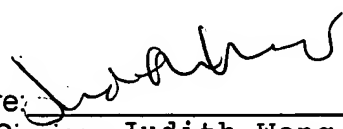


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#### CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 07/29/2008

Signature:   
Person Signing: Judith Wong